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TO:

NAME	Mr. Peter Szekely, Primary Examiner
COMPANY	USPTO
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YOUR REFERENCE NO.	Serial # 09/398,377 - Art Unit 1714 - Supplemental Reply

FROM:

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OUR REFERENCE NO.	12969.00

MESSAGE:

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Docket No. 12969

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE#23/m
10.22.02

5 Applicant: Bitler et al

Group Art Unit: 1714

Serial No.: 09/398,377

Examiner: Peter Szekely

Filing Date: September 17, 1999

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Title: Polymeric Thickeners for Oil-containing Compositions

Assistant Commissioner for Patents

Washington, DC 20231

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SUPPLEMENTAL REPLY

Sir,

This paper is a supplemental reply to the Office Action mailed July 31, 2002. Reexamination, reconsideration and allowance of the rejected claims are respectfully requested in view of the Remarks below, particularly in view of the law cited below and the accompanying declaration of David C. Steinberg, expert on the chemistry of cosmetic products.

20

1. New Matter Rejection and The Rejection of Claims 2, 7-10, 12-14 and 21-26 for Lack of Written Description

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The specification was amended to add "the polymeric thickener should be used in an amount sufficient to thicken the oil"

30

Each of claims 2, 7-10, and 12-14 requires, directly or indirectly, that the SCC polymer" is present in amount such that it thickens the oil". Claim 21, and

CERTIFICATE OF FACSIMILE

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Signed: 

Betty LaRuegui

claims 22-26 dependent thereon, as examined, had the same requirement, but no longer contain that requirement in view of the amendment made to claim 21.

The stated basis for the new matter rejection and the rejection of these claims
5 for lack of written description is:

There is no mention in the original specification of a side chain crystalline polymer being 'present in amount such that it thickens the oil'.

According to the applicable law,
10 [w]hen determining when the disclosure is sufficient,
the test . . . is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter[.]"

Turbocare v. General Electric Co., 264 F.3d 1111, 1118, 60 U.S.P.Q. 2d 1017 (Fed. Cir.
15 2001) (quoting Vas-Cath, Inc. v Mahurkar, 935 F. 2d 1555, 1563, 19 U.S.P.Q 2d 1111, 1116 (Fed. Cir. 1991)).

In his declaration, David C. Steinberg, expert in the chemistry of cosmetic products, unequivocally states in paragraph 9:

20 *It is my opinion that the language "The polymeric thickener should be used in an amount sufficient to thicken the oil" is inherently within the original disclosure and one skilled in the art would recognize that this was disclosed. Further, It is my opinion that the original disclosure reasonably conveyed to one skilled in the art that the inventor had possession of the claimed subject matter at the time of*
25 *filing, in particular the subject matter of claims 2, 5, 7-10, 12-14 and 17-27.*

Dr. Steinberg provides ample factual basis for his opinion.

There is no evidence contrary to Mr. Steinberg's opinion. As such, withdrawal of
30 this rejection is respectfully requested.

2. The Rejection of Claims 2, 7-10, 12-14 and 21-26 for Lack of Enablement.

Claims 2, 7-10, 12-14 and 21-26 have been rejected for lack of enablement. The stated basis for this ground of rejection is:

5 *There is no showing in the specification to instruct one of ordinary skill in the art about the minimum amount of side chain crystalline polymer which is necessary to thicken the claimed oils.*

10 In the previous reply, Applicant pointed out examples in the specification, which instruct one of ordinary skill in the art about the minimum amount of side chain crystalline polymer which is necessary to thicken the claimed oils. It is well settled law that,

15 *[t]here is no magical relation between the number of representative examples and the breadth of the claims; the number and variety of examples are irrelevant if the disclosure is "enabling" and set forth in the "best mode contemplated."*
In Re Borkowski, 164 U.S.P.Q. 642, 646 (CCPA 1970); see also In re Angstadt, 537 F.2d 498 (C.C.P.A. 1978).

Further, Mr. Steinberg states in his declaration, at paragraph 10:

20 *[i]t is my opinion that the claimed subject matter is described in the original specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected to make and/or use the invention without undue experimentation, in particular, the subject matter of claims 2, 5, 7-10, 12-14 and 17-27.*

25

Mr. Steinberg goes on to say in paragraph 10 part iii:

30 *using the compounds (polymers) and oils disclosed in the specification, it would only take one skilled in the art and having the necessary equipment a short amount of time to determine the amount of polymer needed to achieve the desired thickness.*

Applicant asserts, therefore, that the specification contains enablement commensurate in scope with the protection sought by the claims.

It is well-settled law that under the present circumstances, a rejection of lack of
5 enablement must be withdrawn unless the Examiner substantiates the rejection by
reason or evidence. For example, the CCPA, in In re Budnick, 190 USPQ 422,
observed,

*Where an applicant has asserted that the specification contains enablement
commensurate in scope with the protection sought by the claims, but the
10 Examiner is of the opinion that the disclosure is not enabling, he has the burden
of substantiating his doubts concerning enablement with reason or evidence.*

In the present case, the Examiner has not substantiated his doubts in anyway.
He has merely **asserted** that the specification is not enabling. It is submitted, therefore,
15 that the rejection should be withdrawn.

3. The Rejection of Claims 5, 9, 17-20 and 27 for Lack of Written Description

Each of claims 5, 9, 20 and 27 requires, directly or indirectly, that the composition
20 contains at least 3% by weight of the SCC polymer. Claim 17, and claims 18-19
dependent thereon, as examined, had the same requirement, but no longer contain that
requirement in view of the amendment made to claim 17.

The stated basis for the rejection of these claims for lack of written description is:
25 *There is no mention in the original specification or the original claims of "at least
3% by weight" of a side chain crystalline polymer. Only the 3-10% by weight
range is mentioned on page 9, lines 12-14 of the original specification.*

As previously stated, when determining when the disclosure is sufficient the test . . . is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter

5 Turbocare v. General Electric Co., 264 F.3d 1111,1118, 60 U.S.P.Q. 2d 1017 (Fed. Cir. 2001) (quoting Vas-Cath, Inc. v Mahurkar, 935 F. 2d 1555, 1563, 19 U.S.P.Q 2d 1111, 1116 (Fed. Cir. 1991)).

10 In his declaration, with a factual basis specified, Mr. Steinberg, states in paragraph 9:

15 *It is my opinion that the language "The polymeric thickener should be used in an amount sufficient to thicken the oil" is inherently within the original disclosure and one skilled in the art would recognize that this was disclosed. Further, It is my opinion that the original disclosure reasonably conveyed to one skilled in the art that the inventor had possession of the claimed subject matter at the time of filing, in particular the subject matter of claims 2, 5, 7-10, 12-14 and 17-27.*

20 There is no evidence contrary to Mr. Steinberg's opinion. As such, withdrawal of this rejection is respectfully requested.

4. The Rejection of Claims 5, 9, 17-20 and 27 for Lack of Enablement

25 Each of claims 5, 9, 20 and 27 requires, directly or indirectly, that the composition contains at least 3% by weight of the SCC polymer. Claim 17, and claims 18-19 dependent thereon, as examined, had the same requirement, but no longer contain that requirement in view of the amendment made to claim 17.

30

The stated basis for the rejection of these claims for lack of enablement is:

The specification, while being enabling for 3-10% by weight of side chain crystalline polymer, does not reasonably provide enablement for 3-100% by weight of side chain crystalline polymer.

5

In the previous reply, Applicant pointed out examples in the specification that support claims in which the composition contains at least 3% by weight of the SCC polymer.

It is well settled law that,

10

[t]here is no magical relation between the number of representative examples and the breadth of the claims; the number and variety of examples are irrelevant if the disclosure is "enabling" and set forth in the "best mode contemplated[.]"

In Re Borkowski, 164 U.S.P.Q. 642, 646 (CCPA 1970).

15

In his declaration, at paragraph 10, Mr. Steinberg states:

[i]t is my opinion that the claimed subject matter is described in the original specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected to make and/or use the invention without undue experimentation, in particular, the subject matter of claims 2, 5, 7-10, 12-14 and 17-27.

20

Mr. Steinberg goes on to say at paragraph 10, part iii:

[u]sing the compounds (polymers) and oils disclosed in the specification, it would only take one skilled in the art and having the necessary equipment a short amount of time to determine the amount of polymer needed to achieve the desired thickness.

25

Applicant asserts, therefore, that the specification contains enablement commensurate in scope with the protection sought by the claims.

30

Moreover, the present situation is similar to that In re Johnson and Farnham, 558 F.2d 10008, 1017, 194 U.S.P.Q. 187, 195 (CCPA 1977), where the examiner rejected claims for lack of enablement. The examiner tried to restrict the claims based on

5 ranges given in the description of the best mode. In its decision, the CCPA stated:

[t]he PTO would limit appellants to claims reciting a sigma value of at least 0.7.*

This view is improper because it requires the claims to set forth the practical limits of operation for the invention and it effectively ignores the scope of enablement provided by the specification as a whole. As we said in In re Goffe, 542, F.2d 564, 567, 191 U.S.P.Q. 429, 431 (CCPA 1976):

[T]o provide effective incentives, claims must adequately protect inventors.

To demand that the first to disclose shall limit his claims to what he found will work or to materials which meet the guidelines specified for "preferred" materials in a process such as the one herein involved would not serve

15 *the constitutional purpose of promoting progress in the useful arts. See In re Fuetterer, 50 CCPA 1453, 1462, 319 F.2d 259, 265, 138 U.S.P.Q. 217, 223 (1963) [footnote omitted]*

See also In re Geiger, 815 F.2d. 686, 690, 2 U.S.P.Q. 2d 1276, 1276 (Fed. Cir. 1987).

20 Likewise, Applicant's should not be required to restrict their claims to a preferred embodiment given in the specification.

It is well-settled law that under such circumstances, a rejection of lack of enablement must be withdrawn unless the Examiner substantiates the rejection by 25 reason or evidence. For example, the CCPA, in In re Budnick, 190 USPQ 422, observed

Where an applicant has asserted that the specification contains enablement commensurate in scope of the protection sought by the claims, but the Examiner is of the opinion that the disclosure is not enabling, he has the burden of
30 *substantiating his doubts concerning enablement with reason or evidence.*

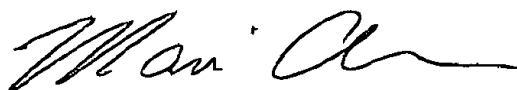
In the present case, the Examiner has not substantiated his doubts in anyway. He has merely **ass rted** that the specification is not enabling. It is submitted, therefore, that the rejection should be withdrawn.

5

CONCLUSION

For the above stated reasons, in addition to the reasons given in the reply mailed September 27, 2002, it is believed that this application is now in condition for allowance, and such action at an early date is earnestly requested. If, however, there are any
10 outstanding issues that could usefully be discussed by telephone, the Examiner is asked to call the undersigned.

Respectfully submitted,



15

Mauri L. Aven

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